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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/796,231

03/09/2004

Marc Husemann

tesa 1649-WCG

2181

27386

7590

02/23/2007

NORRIS, MCLAUGHLIN & MARCUS, P.A.

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NEW YORK, NY 10022

EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT

PAPER NUMBER

1714

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|----------------------------------------|-----------|---------------|
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3 MONTHS

02/23/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/796,231

**Applicant(s)**

HUSEMANN ET AL.

**Examiner**

Katarzyna Wyrozebski

**Art Unit**

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

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In view of applicant's response dated 1/24/2007 following office action is final.

Applicants arguments were not persuasive and did not overcome the prior art of record. The rejections of record are incorporated here by reference.

***Claim Rejections - 35 USC § 112***

Applicant's arguments regarding NORISH I and NORISH II overcome 112 rejection of record.

Applicant's arguments with respect to term "substituted" and "derivatives" are not persuasive and the rejection of record is incorporated here by reference.

The examiner would like to point out that the applicant's specification does not provide clear and concise definition as to what term "derivative" and "substituted" are defined as. Therefore the claims are considered indefinite. The applicants pointed out that the prior art of record uses term "derivative" in col. 2, line 32. The examiner is in total agreement with the applicants, however, that term is not utilized in claims but in the body of the specification.

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-4, 6-8, 10-13, 18-27, 31, 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by PARSONS (US 5,851,663).

The disclosure of PARSON from paragraph 5 of the first office action on the merits dated 10/24/2006 is incorporated here by reference.

3. Claims 1-15, 17, 19, 21-29 are rejected under 35 U.S.C. 102(a or e) as being anticipated by SAKURAI (US 6,893,583 or US 2002/0193487).

The disclosure of SAKURAI from paragraph 6 of the first office action on the merits dated 10/24/2006 is incorporated here by reference.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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5. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over PARSONS (US 5,851,663) or SAKURAI (US 6,893,583 or US 2002/0193487) either one of which in view of NISHIMURA (US 2005/0227065).

The disclosure of PARSONS or SAKURAI either one of which in view of NISHIMURA from paragraph 10 of the first office action on the merits dated 10/24/2006 is incorporated here by reference.

***Response to the Arguments***

*The prior art of PARSONS (US 5,851,663)*

a) No person skilled in the art reading this reference, would ever learn that the ammonium phosphate could be used in an adhesive composition comprising acrylate component and resin.

With respect to the above argument, if the applicants take a look at the title and the abstract of the disclosure of PARSONS, it reads "Flame Retardant Pressure Sensitive Adhesive and Tapes". The Abstract further reads on acrylic adhesives and rubber resin. Right at the beginning of the entire disclosure.

b) The applicants have further indicated that the composition has good results without being combined with such second compounds.

The examiner request clarification of this statement, since it is not clear as to what the applicants refer to when they say "such second compounds". In addition the results (examiner assumes that the applicants discuss experimental results) are not part of the claims therefore the argument is not commensurate with the scope of the claim.

c) Applicants further argue that the prior art of PARSONS does not use flame retardants since they cause reduction of tackiness of the adhesive.

With respect to the above argument, the prior art of PARSONS does teach flame retardant adhesive (see title and abstract). PARSONS discusses effect of flame retardants on the tackiness but not all flame retardants. Those flame retardants having adverse effect on the tackiness are halogen containing flame retardants. Therefore flame retardants of PARSONS are non-halogenated intumescent flame retardants. Even claims of PARSONS clearly indicate that the flame retardants is polymeric salt containing both phosphorus and nitrogen. Examples 3 and 4 teach use of ammonium polyphosphate.

*The prior art of SAKURAI (US 6,893,583).*

d) The prior art of SAKURAI is preoccupied with curable composition comprising polymerizable vinyl monomer, which is not an adhesive component.

With respect to the above argument, the prior art of SAKURAI discloses flame retardant adhesive composition. It utilizes vinyl monomer that is polymerized in order to form adhesive

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component. For that reducing agent and initiator are utilized. The claims of the present invention do not require the adhesive component to be a polymer. Monomers are also encompassed.

e) The prior art of SAKURAI does not teach use of other resins in the composition.

With respect to the above argument, please kindly see examples and col. 5 of SAKURAI, where rubber resins are utilized.

The obviousness rejection in combination with NISHIMURA.

f) The applicants indicate that no other monomers or components utilized in NISHIMURA can possibly overcome the differences between prior art and the present invention.

There are no differences.

7. Inquiry:

The applicants have submitted an affidavit that is actually a list of patents. The examiner is not clear as to what applicants intended by submitting the list. Is it applicant's search report, or is it IDS? If it is IDS, then it has not been submitted in a proper form that is accepted by the USPTO.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

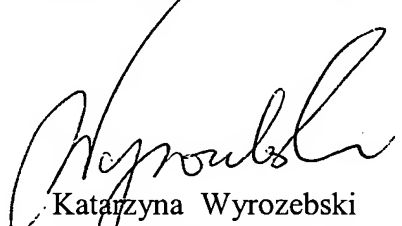
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Katarzyna Wyrozebski  
Primary Examiner  
Art Unit 1714

February 20, 2007